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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/559,128	04/28/2000	Yasushi Kurosawa	P19379	3104

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EXAMINER

CRAIG, DWIN M

ART UNIT	PAPER NUMBER
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2123

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/559,128

Applicant(s)

KUROSAWA ET AL.

Examiner

Dwin M Craig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12-11-2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12-11-2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-16 have been presented for reconsideration in view of Applicant's amended claims language. Claims 17-25 have been presented for Examination.

Response to Arguments

2. Applicants arguments as presented on 12-11-2003 have been fully considered.

Examiner's response is as follows:

2.1 Regarding Applicants response to the 35 U.S.C. 101 rejections of claims 1-6:

The Applicant has amended the claims language so as to be directed towards statutory subject matter. The Examiner withdraws the earlier 35 U.S.C. 101 rejections of Claims 1-6.

2.2 Regarding Applicants response to the 35 U.S.C. 112 2nd paragraph rejection of Claim 1:

Applicant have amended the claims language so as to clarify the "*meets and bounds*" of the claimed subject matter. The Examiner has found applicants arguments to be persuasive and withdraws the 35 U.S.C. 112 2nd paragraph rejection of Claim 1.

2.3 Regarding the 35 U.S.C. 103(a) rejections of Claims 1-16:

Applicant argued:

In the above-referenced Official Action, the Examiner rejected claims 1-16 under 35 U.S.C. § 103(a), as being unpatentable over KOBAYASHI et al. (U.S. Pat. No. 6,488,586) in view of "Advanced Dungeons & Dragons® Players Handbook 2nd Edition" by Steve Winter and Jon Pickens (hereinafter WINTER et al.), and in further view of "Advanced Dungeons & Dragons® Dungeon Masters Guide" by Gary Gygax (hereinafter GYGAX). Applicants' invention, as recited in claim 1, 7 or 13, includes, inter alia, judging whether a level of mastery for each of the at least one ability linked with the possessed item satisfies a predetermined condition, and when the level of mastery for an ability linked with the possessed item satisfies the predetermined condition, giving

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the character the ability for use in the game in accordance with a subsequent operation of the player. The level of mastery for each ability linked with the item is determined in accordance with an activity of the character while possessing the item.

As the Examiner admitted, KOBAYASHI et al. does not disclose that when the level of mastery for an ability satisfies the predetermined condition, the character is given the ability, linked with the item, for use in the game in accordance with a subsequent operation of the player. The Examiner asserted that WINTER et al. discloses that "when the level of mastery of a character, that at least one ability of the character, satisfies a predetermined condition, and the character is given the ability to perform better." However, such a general assertion (i.e., "perform better") is different from features of the P 19379.A05 present invention, as clearly recited in amended claims 1, 7 and 13. In other words, WINTER et al. does not disclose that the level of mastery for each ability linked with the possessed item is determined in accordance with an activity of the character while possessing the item. Further, Winter et al. does not disclose that the ability linked with the possessed item during the activity is given to the character for use in the game in accordance with a subsequent operation of the player.

It is noted by the Examiner that the Gygax reference was relied upon to teach the limitation of that when the level of mastery for ability satisfies the predetermined condition, the character is given the ability, linked with the item, for use in the game in accordance with a subsequent operation of the player. Further, the Examiner has demonstrated that the *Gygax* and *Winter et al.* reference teach that a character in a fantasy role playing game increases it's ability as experience in the game environment is gained. This concept of experience growth of a character in a role playing system, and the increasing of that characters abilities based on an increase in experience or other attributes (*i.e. some swords cannot be used until a characters strength rating is increased above a certain level*) is well known in the Fantasy Role Playing art.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

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Moreover, the Examiner asserted that KOBAYASHI et al. discloses judging whether the level of mastery of an ability of an item satisfies a predetermined condition. However, KOBAYASHI et al. merely discloses "action power," which corresponds to the number of commands allowed. As stated at col. 4 lines 55-61, for example, "input of two or more various commands is acceptable if the total of the action points does not exceed the allowed total action power." Thus, KOBAYASHI et al. does not disclose judging whether a level of mastery for each ability, linked with the possessed item, satisfies a predetermined condition, and that the level of mastery is determined in accordance with an activity of the character while possessing the item, as recited in amended claim 1, 7 and 13.

As disclosed by the Applicant, *see IDS paper #5* current computer games on the market, specifically, *Diablo™* by Blizzard® entertainment has the ability to deny player's characters the ability to access a weapon unless that character's abilities have gone above a certain threshold. The Examiner has personally played this computer game, and knows from personal experience that a player character cannot purchase a sword from the town's blacksmith with out having the requisite strength level to carry the sword.

Thus, neither KOBAYASHI et al. nor WINTER et al. nor GYGAX nor any proper combination thereof discloses the claimed combinations of features of the present invention, as recited in claims 1, 7 or 13.

The Examiner asserts that the combination of *Kobayashi et al.*, *Winter et al.* and *Gygax* are proper. The Examiner respectfully directs the Applicant to a December 1998 article in *MacWorld* magazine, page 78, where the following comment regarding the *Diablo™* game is disclosed, "**WHO ITS FOR** Anyone who's wished Dungeons and Dragons had more adventure and less dice rolling." This comment in this article clearly teaches that *Diablo* is a computerized version of Dungeons and Dragons™ and by Applicant's own admission, *see paper #5 I.D.S.* applicant's claimed invention is a computerized role playing game.

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The Examiner has found Applicant's arguments to be unpersuasive and upholds the 35 U.S.C. 103(a) rejections of Claims 1-16.

An updated search has revealed new art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1-16 and 23-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kobayashi et al. U.S. Patent 6,488,586** in view of **“Advanced Dungeons&Dragons® Players Handbook 2nd Edition”** by **Steve Winter and Jon Pickens**, hereafter referred to as the *Winter et al.* reference, and in further view of **“Advanced Dungeons&Dragons® Dungeon Masters Guide”** by **Gary Gygax**, hereafter referred to as the *Gygax* reference.

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3.1 As regards independent Claims 1, 7 and 13 the *Kobayashi et al.* reference discloses a computer readable program product for storing a game program (**Figures 1, 21 and 22, Col. 1 Lines 35-45, Col. 3 Lines 57-67, Col. 4 Lines 1-29**), *that when the game program is executed on a processor*, allows for the creation of a character (**Figures 2**) with at least one ability (**Figure 2 Items 104a and 104b**) and at least one item (**Figure 2 Items 104c and 104d**) and judging whether the level of mastery of at least one ability of at least one item satisfies a predetermined condition (**Figures 2-15, Col. 4 Lines 55-67, Col. 5 Lines 1-48, Col. 6 Lines 47-59**).

However, the *Kobayashi et al.* reference does not expressly disclose that when the level of mastery, of at least one ability, satisfies a predetermined condition, the character is given the ability, linked to an item, to enable use of the item with subsequent operations of the player.

The *Winter et al.* reference discloses that when the level of mastery of a character, that at least one ability of the character, satisfies a predetermined condition, and the character is given the ability to perform better (**Chapter 8: Experience, pages 88-89 and Chapter 9: Combat, specifically pages 89-91 “CALCULATED THAC0S**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Winter et al.* reference because, by improving the characters experience and abilities in a role playing game a user will want to play the game more and more in the hopes of being rewarded with greater levels of abilities, (**Advanced Dungeons&Dragons® Player’s Handbook, 2nd Edition, page 88**).

The *Gygax* reference discloses enabling the use of an “*item*” that enables special abilities in a character (**TREASURE-Miscellaneous Magic-Swords pages 165-169**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Gygax* reference because, using magic items in a role playing game enhances the ability of a character to gain experience and thus improve the characters effectiveness in the role playing world which motivates the player to want to play the game more.

3.2 As regards dependent **Claims 2, 8 and 14** the *Kobayashi et al.* reference discloses protective gear (**Figure 2 Item 104c**) and a weapon (**Figure 2 Item 104d**).

3.3 As regards dependent **Claims 3, 9 and 15** the *Kobayashi et al.* reference does not expressly disclose “*experience points*.”

The *Winter et al.* reference discloses “*experience points*” (**Chapter 8: Experience, pages 88-89**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Winter et al.* reference because, by improving the characters experience and abilities in a role playing game a user will want to play the game more and more in the hopes of being rewarded with greater levels of abilities, (**Advanced Dungeons&Dragons® Player’s Handbook, 2nd Edition, page 88**).

3.4 As regards dependent **Claims 4, 10 and 16** the *Kobayashi et al.* reference does not expressly disclose awarding “*victory points*.”

The *Winter et al.* reference discloses awarding “*victory points*” (**Chapter 8: Experience, page 88 “Individual Experience Awards”**).

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It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Winter et al.* reference because, by improving the characters experience and abilities in a role playing game a user will want to play the game more and more in the hopes of being rewarded with greater levels of abilities, (**Advanced Dungeons&Dragons® Player's Handbook, 2nd Edition, page 88**).

3.5 As regards dependent **Claims 5, 6, 11 and 12** the *Kobayashi et al.* reference does not expressly disclose the use of *Magic*.

The *Gygax* reference discloses the use of *Magic* (**TREASURE-Miscellaneous Magic-Swords pages 165-169**).

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have modified the *Kobayashi et al.* reference with the *Gygax* reference because, using magic items in a role playing game enhances the ability of a character to gain experience and thus improve the characters effectiveness in the role playing world which motivates the player to want to play the game more.

3.6 As regards **Claims 23-25** the *Kobayashi et al.* reference (**Col. 5, 40-49**) discloses offensive and defensive weapons.

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4. **Claims 17-22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kobayashi et al. U.S. Patent 6,488,586** in view of “**Advanced Dungeons&Dragons® Players Handbook 2nd Edition**” by **Steve Winter and Jon Pickens**, hereafter referred to as the *Winter et al.*

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reference, and in further view of “**Advanced Dungeons&Dragons® Dungeon Masters Guide**” by Gary Gygax, hereafter referred to as the *Gygax* reference and in further view of “*Diablo, Fresh take on an old tale*”, by Cameron Crotty (*MacWorld Magazine*).

4.1 As regards dependent **Claims 17, 18 and 19** the *Kobayashi et al.* reference does not expressly disclose the a character being able to have an ability without possessing an item.

However, *Crotty* reference when disclosing information about the computer game *Diablo™* discloses the ability of a character to have an ability without possessing an item. *Specifically, the character can consume a potion bottle of mana, see figure on page 64, and while NOT possessing the bottle of potion perform magic spells using the mana.*

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have combined the computer role playing technology of the *Kobayashi et al.* reference with the *computer role playing technology* of the *Crotty* reference because the *Diablo* game is a computerized version of Dungeons and Dragons (see page 64, **MacWorld Magazine August 1998**), and people like playing computerized role playing games because they do not have to roll the dice as often and keep track of all the game information manually.

4.2 As regards dependent **Claims 20-22** the *Kobayashi et al.* reference does not expressly disclose the a character gaining experience points during a fight.

The *Crotty* reference discloses a character gaining hit points during a fight (*in the Diablo game a character can take a potion to rejuvenate his character and restore life.*)

It would have been obvious, to one of ordinary skill in the art, at the time the invention was made, to have combined the computer role playing technology of the *Kobayashi et*

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al. reference with the *computer role playing technology* of the *Crotty* reference and *to allow a character to add experience points during a battle and not just at the end of the battle*, because the *Diablo* game is a computerized version of Dungeons and Dragons (see page 64, **MacWorld Magazine August 1998**), and people like playing computerized role playing games because they do not have to roll the dice as often and keep track of all the game information manually and being able to proactively improve a characters performance during a battle adds to the enjoyment of the role playing game, thus making the product more popular and *marketable/profitable*.

Conclusion

5. **Claims 1-25** are rejected.

5.1 Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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5.2 Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwin M Craig whose telephone number is 703 305-7150. The examiner can normally be reached on 10:00 - 6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DMC



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